

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric J. Hansen and Jesse J. Williams

For: EXTRACTION CLEANING WITH OXIDIZING AGENT

Serial No.: 09/589,973 Examiner: Derrick G. Hamlin

Filed: 06/08/00 Group Art Unit: 1751

Atty. Docket: 71189-1300 Confirmation No.: 9893

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CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))	
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Date: <u>July 1, 2003</u>	Signature: <u>Christine M. Judge</u> (type or print name of person certifying)

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

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TC 1700REQUEST FOR RECONSIDERATION AND FOR FURTHER INTERVIEW

Applicants hereby request reconsideration of the Examiner of the rejection of the claims in view of the foregoing remarks. In the event that the Examiner does not believe that the claims are allowable upon reconsideration, Applicants request the courtesy of a personal or telephone interview with Examiner Hamlin and his supervisor, Dr. Gupta. Dr. Gupta suggested this procedure in a telephone conference with Dr. Gupta on June 25, 2003.

Applicants request reconsideration of the rejection of the claims in view of the Examiner's Advisory Action, which gave the Examiner's reasons why he believed that Applicants' arguments and evidence submitted did not overcome the rejection of the claims. It is apparent to Applicants' attorney from the Advisory Action, as well as from a telephone interview with Examiner Hamlin on May 30, 2003, that Examiner Hamlin has misconstrued the

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significance of the evidence presented by Applicants in response to the Final Rejection and perhaps has not appreciated the relationship of the evidence to the law which must be applied by the Patent Office in deciding the issue of patentability.

In the Examiner's Detailed Action in the Advisory Action mailed May 29, 2003, the Examiner dismissed the Declaration of Kelli Cain because he did not understand how the commercial success of the invention could be shown by sales of products of other people. In addition, the Examiner dismissed the Declaration of Jesse Williams because Mr. Williams had conducted no experiments using the composition of Miracle to prove his assertion, nor had he shown superior or unexpected results over the prior art reference. The Examiner further asserted that the Declaration of Mr. Williams was not probative because it failed to show that the bleaching additive of Miracle in all concentrations would not be effective "(not commensurate in scope)" and that the bleaching composition might lighten the carpet. The Examiner further asserted that the Applicants had failed to prove that the bleaching additive of all concentrations would lighten a carpet and the instant composition would not. These statements indicate that the Examiner has not appreciated the significance of the evidence and the law that must be applied by the Patent Office with respect to this evidence.

The evidence submitted herewith raises two issues that are separate and distinct. Both issues relate to the obviousness of the claimed invention over a combination of references and whether a person having ordinary skill in the art to which the invention pertains would have made the combination of references. If the combination of references cannot tenably be made, the rejection fails and must be withdrawn irrespective of any comparative evidence.

DECLARATION OF JESSE WILLIAMS UNDER 37 C.F.R. § 1.132

Perhaps a good starting point with respect to this Declaration is 37 C.F.R. § 1.132. This rule states in pertinent part as follows:

Section 1.132: Affidavits or Declarations traversing grounds of rejection.

When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes

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but does not claim the invention, or on reference to a foreign patent or to printed publication, or to facts within the personal knowledge of an employee of the Offices, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged inventions held to be inoperative or lacking in unity, or frivolous, or injurious to public health or morals, affidavits or declarations versing the rejections or objections may be received.

In this case, the Declaration of Jesse Williams relates to the Examiner's holding of obviousness of the alleged combination of the Miracle et al. '282 patent with either the Sham '612 or the Ligman '595 patents. The issue that Mr. Williams addresses in his Declaration is whether one having ordinary skill in the art of extraction carpet cleaning would have believed that the Miracle bleaching composition could be used in any extraction cleaning machine and in particular the extraction cleaning machines of Sham and Ligman and thus made the alleged combination. In other words, would a person having skill in the art of extraction cleaning of carpets (the subject matter of the invention), with knowledge of the Miracle et al. '282, Sham '612 and Ligman '595 patents, have thought it obvious to use the bleaching composition of the Miracle et al. '282 patent in the extraction cleaning machines of Sham '612 or the Ligman '595 to carry out the claimed process of Applicants' invention.

Mr. Williams is qualified to make this Declaration because he is a person skilled in the art of carpet cleaning with extraction cleaning machines, the subject matter of this invention. His Declaration sets forth his credentials and qualifies him to give an opinion as to the accuracy of the Examiner's statement of whether it would have been obvious to use the Miracle et al. '282 bleaching composition in the Ligman or Sham extraction cleaners. That is the sole issue that Mr. Williams addresses in his Declaration. The question is not whether the invention is patentable over the combination of references but whether the references themselves can be tenably combined under 35 U.S.C. § 103(a) in the manner alleged by the Examiner.

Mr. Williams opines that the alleged combination of prior art disclosures of Miracle et al. '282 and Sham or Ligman would not have been appropriate to one having ordinary skill in the art of extraction carpet cleaning. Mr. Williams gives the following reasons for his opinion that this conclusion would not have been obvious. The Miracle bleaching composition has heavy

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surfactants that require multiple rinse cycles that are present in washing machines but not in carpet extractors. These heavy surfactants would result in carpet resoiling that one with the experience of Mr. Williams would understand would be inappropriate for use in carpet cleaning extractors. That is not to say that the bleach boosters of the Miracle et al. '282 patent might not be useful in carpet shampoos. That is not the issue raised by the Examiner. The issue whether these particular bleach boosters disclosed in Miracle would be appropriate for use in extraction cleaning machines to a person of ordinary skill in the art of carpet extraction. Mr. Williams has opined that they would have not been appropriate for use in these machines because of the likelihood of resoiling a carpet. Therefore, it would not have been obvious to use the Miracle bleach boosters in either of the Sham '612 or the Ligman '595 extraction cleaners.

No tests need to be performed to support Mr. Williams's opinion. He is qualified to give these opinions just as any expert is qualified to give opinions of what he might expect to encounter if he ran experiments. Nor is he required to show that the composition of the invention would be better than the Miracle bleach boosters in an extraction cleaning machine. Once again, the issue is the combinability of references not the patentability of the claimed invention over the combination of references.

The Examiner has given no reason as to why Mr. Williams's expert testimony is not competent. It must be considered by the Examiner under 37 C.F.R. § 1.132. If Mr. Williams's testimony is to be given weight, then the alleged combination of Miracle et al. '282 and either Sham or Ligman is not proper and the rejection must be withdrawn.

COMMERCIAL SUCCESS-THE KELLI CAIN DECLARATION.

The evidence presented by the Kelli Cain Declaration raises another issue. The issue addressed in the Cain Declaration is the obviousness of the alleged combination of references, assuming that the Examiner has made a *prima facie* case of unpatentability based on the combination of references. Commercial success is one of the factors that is mentioned as evidence of non obviousness in the seminal case of Graham v. John Deere, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467. Where Graham factors are present in a case, the Patent Office

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must consider the Graham factors before reaching the conclusion of obviousness. Locktight Corporation v. Ultra Seal Limited, 781 F.2d 861, 228 U.S.P.Q. (BNA) 90 (Fed. Cir. 1985).

The commercial success of the invention may be achieved by the Applicants and/or it may be achieved by others subsequent to the invention by the Applicants. Commercial success of the invention means that the invention as claimed has achieved commercial success, regardless of who achieves that success. See, for example, Brown & Williamson Tobacco Corp. v Phillip Morris, Inc., 229 F. 3d 1120 at 1124, 1130 (Fed. Cir. 2000) (the success of an alleged infringing product can demonstrate the commercial success of a patented invention). Further, that commercial success must be related to the invention as claimed.

The claims in this application relate to a process of cleaning a carpet. The only difference between conventional carpet extraction cleaning and the process according to the invention is the use of an oxidizing composition that is applied to the floor with the cleaning composition. Claim 1 does not have any compositional limits. The evidence submitted by Kelli Cain shows that the method of claim has achieved commercial success by Applicants' Assignee, BISSELL Homecare, Inc., as well as by Oxiclean.

The evidence of commercial success must be given weight before the Examiner reaches a conclusion of obviousness. The Examiner has not give weight to the evidence of commercial success before reaching a conclusion of obviousness.

In view of the foregoing, it is believed that the rejections of the claims over the Miracle et al. '282 patent in view of the Sham '612 or the Ligman '595 patents is inappropriate and should be withdrawn. The courtesy of a personal or telephone interview is requested in the event that the Examiner is still not persuaded that the claims are patentable over the alleged combination of references.

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Respectfully submitted,

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Dated: 6.30.03

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